

REMARKS

I. Introduction

With the addition of new claims 24 and 25, claims 1 to 3, 9 and 11 to 25 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 1, 3, 9, 11 to 15 and 18 to 22 Under 35 U.S.C. § 103(a)

Claims 1, 3, 9, 11 to 15 and 18 to 22 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 5,678,372 (“Thomson et al.”) and U.S. Patent No. 4,372,092 (“Lopez”). It is respectfully submitted that the combination of Thomson et al. and Lopez does not render unpatentable the presently pending claims for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See KSR Int'l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). Further, the Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. M.P.E.P. §2143.

Claim 1 relates to a modular building system, including, *inter alia*, the features of (a) multiple portable pre-cast modules, in which each of the multiple modules comprises (i) structural steel mesh; (ii) cementitious mortar encasing the structural steel mesh; and (iii) *tapered indentations located along edges of the module and exposing portions of the structural steel mesh, each exposed portion of the structural steel mesh traversing a respective tapered indentation along a line parallel to a respective edge of the module along which the respective tapered indentation is located*. Support for the amendments to claim 1 may be found in the specification, e.g., at Figures 1A to 4.

The combination of Thomson et al. and Lopez does not disclose, or even suggest, all of the features included in claim 1. In this regard, Thomson et al.

merely describes terminal ends 51 of reinforcement bars 50 extending from vertical edges 52. Col. 5, lines 15 to 18; and Figures 2 to 6. Thus, the terminal ends 51 of Thomson et al. extend **perpendicularly** from the vertical edges 52. Nowhere does Thomson et al. disclose exposed portions of structural steel mesh that traverse tapered indentations along a line parallel to the edge along which the tapered indentations are located. Instead, Thomson et al. merely describes additional vertical reinforcement bars 48 and zig-zag reinforcement bars 64, around which the terminal ends 51 are bent. Col. 5, lines 38 to 56. Further, Thomson et al. asserts particular advantages of its complicated knitting structure, specifically including the terminal ends 51, vertical reinforcement bars 48 and zig-zag reinforcement bars 64. Col. 5, line 57 to col. 6, line 6. Accordingly, Thomson et al. does not disclose, or even suggest, the features of *tapered indentations located along edges of the module and exposing portions of the structural steel mesh, each exposed portion of the structural steel mesh traversing a respective tapered indentation along a line parallel to a respective edge of the module along which the respective tapered indentation is located*. Moreover, Lopez also does not disclose the above-recited features of claim 1.

Therefore, the combination of Thomson et al. and Lopez does not disclose, or even suggest, the features of *tapered indentations located along edges of the module and exposing portions of the structural steel mesh, each exposed portion of the structural steel mesh traversing a respective tapered indentation along a line parallel to a respective edge of the module along which the respective tapered indentation is located*, as provided for in the context of claim 1.

Accordingly, it is respectfully submitted that the combination of Thomson et al. and Lopez does not disclose, or even suggest, all of the features included in claim 1. Therefore, it is respectfully submitted that the combination of Thomson et al. and Lopez does not render unpatentable claim 1 for at least the foregoing reasons.

Thus, as for claims 3, 9, 11 to 15 and 18 to 22 which ultimately depend from claim 1 and therefore include all of the features included in claim 1, it is respectfully submitted that the combination of Thomson et al. and Lopez does not render unpatentable these dependent claims for at least the reasons more fully set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 2, 16, 17 and 23 Under 35 U.S.C. § 103(a)

Claims 2, 16, 17 and 23 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Thomson et al., Lopez and U.S. Patent No. 7,121,061 (“Jazzar”). It is respectfully submitted that the combination of Thomson et al., Lopez and Jazzar does not render unpatentable the presently pending claims for at least the following reasons.

Claims 2, 16, 17 and 23 ultimately depend from claim 1. As more fully set forth above, the combination of Thomson et al. and Lopez does not disclose, or even suggest, all of the features included in claim 1. Jazzar also does not disclose, or even suggest, the features included in claim 1 not disclosed by the combination of Thomson et al. and Lopez, and thus, fails to cure the critical deficiencies noted above.

Accordingly, it is respectfully submitted that the combination of Thomson et al., Lopez and Jazzar does not disclose, or even suggest, all of the features included in claim 1, from which claims 2, 16, 17 and 23 ultimately depend. As such, it is respectfully submitted that the combination of Thomson et al., Lopez and Jazzar does not render unpatentable claims 2, 16, 17 and 23, which ultimately depend from claim 1.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

IV. New Claims 24 and 25

New claims 24 and 25 have been added herein. It is respectfully submitted that claims 24 and 25 add no new matter and are fully supported by the present application, including the specification, e.g., at Figure 4.

It is respectfully submitted that claims 24 and 25, which ultimately depend from claim 1, are patentable over the references relied upon for at least the reasons more fully set forth above in support of the patentability of claim 1.

V. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Date: June 3, 2011

By: /Clifford A. Ulrich/
Clifford A. Ulrich
Reg. No. 42,194

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646